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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,715	11/16/2000	Timothy G.J. Jones	57.0272PCT	6188

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EXAMINER	
LIPMAN, BERNARD	
ART UNIT	PAPER NUMBER
1713	10

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

(10)

Office Action Summary	Application No. 09/646,715	Applicant(s) JONES ET AL.	
	Examiner Bernard Lipman	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-48* is/are pending in the application.

4a) Of the above claim(s) *10-28 (duplicates of renumbered 29-47)* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *29-48* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. This application contains claims directed to the following patentably distinct species of the claimed invention: A specific combination of identified structural backbone of the polymer with specific hydrophobic entities specified along with functionalities for each and in combination with specific cross-linking agent.

Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 29 as renumbered is generic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.

2. Applicants are notified that the claims presented in the amendment accompanying the request for CPA have been renumbered from the submitted numbers 10-29 to the amended numbers according to Rule 126 of 29-48. This is because of the difference in these claims represented by the additional claim over the claims presented previously, but not entered, which had been numbered 10-28. These non-entered claims should be officially cancelled and the new claims renumbered 29-48 as has been done here in this application.

3. Claims 29-48 are rejected under 35 U.S.C. § 112, first paragraph as broader than one of ordinary skill in the art is enabled to practice the invention. The claims continue to be broader than one of ordinary skill in the art is enabled, from the disclosure, to practice the invention insofar as one of ordinary skill in the art is only given enough information to practice the claimed method using specific polymers with

backbones as identified in the disclosure in combination with hydrophobic entities identified and specific types of cross-linking. Only the combination of all three things are enabled to one of ordinary skill in the art. The claims, however, continue to read on broad areas of functionality as well as non-enabled combinations of functionalities between the polymers and the cross-linking functionalities. The claims are, therefore, still properly rejected under 35 U.S.C. § 112, first paragraph.

This rejection under 35 U.S.C. § 112 is made in order to expedite prosecution of this application. Consideration of the prior art is held in abeyance pending resolution of the election requirement presented herein.

B. Lipman:cdc
(703) 308-0661
September 3, 2002

BERNARD LIPMAN
PRIMARY EXAMINER